

Remarks

Copies of Certified Priority Documents

Included in this filing are certified copies of German patent applications 102 41 068.2 filed 5 September 2002 and 102 15 715.4 filed 10 April 2002.

Objection to Claim 1

The Examiner objected to Claim 1 for the inclusion of a duplication of the phrase “and a sensor line.” Applicants thank the Examiner for pointing g out this error. Applicants have amended Claim 1 to delete the first occurrence of “and a sensor line” on line 5 of Claim 1 and respectfully request reconsideration and withdrawal of the objection to Claim 1.

The § 102 (b) rejections of Claims 1-4, 6, 7, and 9-14

The Examiner rejected Claims 1-4, 6, 7, and 9-14 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,394,043 to Hsia (“Hsia” or “the Hsia patent”). Applicants have amended Claim 1. Applicants respectfully traverse these rejections and request reconsideration.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.) In addition, “Every element of the claimed invention must be literally present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicants respectfully submit that Hsia fails to disclose each element of amended independent Claim 1 as they are arranged in that claim. Specifically, Hsia fails to disclose a fixed bearing mounted against the side of the injected molded part that faces axially away (opposite) from the shaft output of the motor. Applicants courteously point to Figure 5 of the specification in which fixed bearing 14 is shown against the side opposite the output end of the rotor shaft. This also described in paragraph 0020 of the specification. In contrast, the figure in Hsia shows shaft 36 mounted on fixed bearing 54 on the output end of the shaft. In this regard, Applicants respectfully traverse the Examiner’s statement that in the Hsia

patent, motor shaft 36 is mounted against fixed bearing 78 which is opposite the output end of the shaft. Although fixed bearing 78 is opposite the output end, shaft 36 is not mounted in fixed bearing 78. Applicants courteously points to reference no. 80 in the Hsia figure which separates shaft 36 from fixed bearing 78. Moreover, fixed bearing 78 is described as supporting journal plug 80. (See col. 3, lines 26-28 stating, "Journal plug 80 has a first diameter portion 84 extending for the inner axial end face and on which bearing assembly 78 is journalled.") In addition, Applicants courteously submit that Hsia fails to disclose a floating bearing supporting the output end of the shaft as claimed in amended Claim 1 and described in paragraphs 0011 and 0020. Therefore, because Hsia fails to disclose all the elements of Claim 1 as arranged in that claim, it fails as a reference under § 102 (b). Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 1 under § 102 (b).

Claims 2-4, 6, 7, and 9-14 depend directly or indirectly from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Hsia patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2-4, 6, 7, and 9-14. Applicants respectfully request the removal of the rejections of Claims 2-4, 6, 7, and 9-14 under § 102 (b).

The § 103 (a) Rejections of Claims 1-9 and 13

The Examiner rejected Claim 5 under 35 U.S.C. § 103 (a) as obvious over the Hsia patent in view of U.S. Patent No. 5,770,902 to Batten et al. ("Batten" or "the Batten patent") and further in view of U.S. Patent No. 4,902,941 to Merkle et al. ("Merkle" or "the Merkle patent"). Applicants courteously point out that Claim 5 depends from Claim 1 and thus incorporates all the limitations of that claim. Applicants respectfully traverse the rejection of Claim 5 and request reconsideration.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully traverse the Examiner's statement that Hsia shows all the limitations of Claim 5 except the branch supply line and sensor line formed into a pressed screen. Not only does Hsia fail to disclose a branch line and sensor line formed into a pressed screen but, as discussed above, Hsia fails to disclose either a fixed bearing opposite the output end of a motor shaft or the floating bearing at the output end as claimed in Claim 5. Similarly, neither Baker nor Merkle disclose a floating bearing at the shaft output end.

Moreover, Applicants respectfully submit that there is no motivation provided in either Hsia, Baker, or Merkle to combine those three references to establish a *prima facie* case of obviousness against Claim 5. The three references fail to disclose or discuss the problem addressed by Applicants' invention, namely the performance of the motor in response to vibrational stress. (See paragraph 0006 of the pending specification stating, "...because of the arrangement of the fixed bearing on the side axially opposed to the motor, the center of gravity of the present arrangement can be displaced further in the direction of the screw-on surface of the motor housing, whereupon the performance of the motor arrangement according to the invention is response to vibration stresses is improved.") Because Hsia, Baker, and Merkle fail to address or even mention this problem, the person of ordinary skill in the art would not be motivated to combine them to achieve the solution to the problem of vibration stresses in a motor arrangement achieved by the invention of Claim 5, especially as applicants solution is not suggested in any of those references. For this reason, the combined Hsia, Baker, and Merkle patents fail as combined references to render Claim 5 obvious under § 103 (a). Applicants respectfully request reconsideration and passage to allowance of Claim 5.

The Examiner rejected Claim 8 under 35 U.S.C. § 103 (a) as unpatentable over the Hsia patent in view of U.S. Patent No. 4,866,317 to Katayama (“Katayama” or “the Katayama patent”). Applicants respectfully traverse this rejection and request reconsideration.

Applicants courteously point out the Claim 8 depends indirectly from Claim 1 and therefore all the limitations of that claim. Similar to Claim 5 discussed above, Claim 8 includes the limitation in which the output end of the shaft is supported by a floating bearing. As discussed above, Hsia fails to disclose this arrangement. Similarly, the Katayama patent also fails to disclose a floating bearing at the output end of the shaft as claimed in Claim 8. Katayama describes bearing 5a as “...5a which is secured to the inside of the housing 1.” (See Katayama col. 2, lines 21-22. Emphasis added.) In contrast, the instant specification describes floating bearing 23 as supported by the cover, not secured as in the Katayama patent. Applicants respectfully submit that a person of ordinary skill in the art would not look to a combination of the Hsia and Katayama patents to structure a floating bearing because, aside from not directly disclosing or suggesting a floating bearing, neither addresses the problem of control of vibrational stress in a motor shaft solved by Applicants’ claimed invention. Therefore, because neither cited reference discloses or suggests a floating bearing and because neither reference addresses the problem control of vibration in a motor shaft, the combined Hsia and Katayama references fail to establish a *prima facie* case of obviousness against Claim 8. Applicants respectfully request reconsideration and passage to allowance of Claim 8.

The Examiner rejected Claims 1-4, 6, 7, 9, and 13 under 35 U.S.C. § 103 a) as obviousness over U.S. Patent No. 5,610,458 to Baker et al. (“Baker” or “the Baker patent”) in view of Batten. Applicants respectfully traverse this rejection and request reconsideration.

As claimed in amended Claim 1 the output shaft of the claimed motor arrangement is supported by a floating bearing to control vibration of the shaft. Applicants courteously submit that Baker fails to disclose any bearing at all at the output end of the shaft. In Baker, the output end of shaft 24 is surrounded by inner wall 61 of connector boss 83 and cap 25 to include winding termination means 17. (See Figure 5 of Baker.) Similarly, Batten fails to disclose any

bearing at all at the output end 21 of the disclosed motor arrangement, let alone a floating bearing. Applicants courteously point to Figure 1 of Batten which is the only figure depicting a motor with shaft 20, rotor 16, and stator 16. (See col. 4, lines 1-12 in Batten.) Figure 1 contains no disclosure of any type of bearing at the output end of the shaft nor is there an output end bearing of any type discussed in the specification of the Baker patent. Therefore, for this first reason, Applicants respectfully submit the combined Baker and Batten patents fail to establish a *prima facie* case of obviousness against amended Claim 1 as they fail to disclose or suggest all the elements of amended Claim 1, namely a bearing of any type at all at the output end of the motor shaft.

Secondly, Applicants respectfully submit that a person of ordinary skill in the art would not look to the Baker or Batten patents either singly or in combination to render amended Claim 1 obvious. As noted above regarding the Batten patent, the problem of vibration in the motor shaft is not mentioned at all let alone disclosed. Similarly, a person of ordinary skill would not look to the Baker patent as again this problem is not addressed in that patent. Consequently, the Baker and Batten patents, either alone or in combination, fail to establish a *prima facie* case of obviousness against amended Claim 1 as they fail to provide motivation to combine them to render amended Claim 1 obvious, specifically because they do not discuss the problem addressed by Applicants' invention. For this second reason, Applicants respectfully submit the combined Baker and Batten references fail to establish a *prima facie* case of obviousness against amended Claim 1. Applicants respectfully request reconsideration and passage to allowance of Claim 1.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2-4, 6, 7, 9, and 13 depend directly or indirectly from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the combined Baker and Batten patents fail to render obvious all the elements of Claim 1, they also fail to render obvious Claims 2-4, 6, 7, 9, and 13. Applicants respectfully request the removal of the rejections of Claims 2-4, 6, 7, 9, and 13 and passage to allowance of those claims.

The Examiner rejected Claims 8 and 15 under 35 U.S.C. § 103 (a) as obvious Baker in view of Batten and further in view of U.S. Patent No. 6,753,629 to Doi et al. (“Doi” or “the Doi patent”). Applicants courteously note that Claims 8 and 15 depend from amended Claim 1 and thus incorporate all the limitations of Claim 1. Applicants respectfully traverse the rejections of Claims 8 and 15 and request reconsideration.

Applicants respectfully refer the Examiner to the discussion above pointing out that the combined Baker and Batten patents fail to disclose any bearing at the output end of the motor shaft, let alone the floating bearing claimed in Claim 1. Likewise, Doi fails to disclose a bearing(s) on the output end 81 of the shaft 80 but rather depicts bearings 52 supporting rotor 50. In addition, the Doi patent fails to suggest a combination with any patent with any type of bearings of the shaft as it only discloses bearings supporting the rotor and does not disclose or suggest supporting the shaft with bearings. Moreover, Doi, like Baker and Batten, fails address the problem of vibration stress on a motor shaft and thus fails to suggest a combination with the Baker and Batten patents to render Claims 8 and 15 obvious. Applicants respectfully request reconsideration and passage to allowance of Claims 8 and 15.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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